Certificate of Mailing:
The undersigned certifies that this correspondence is being deposited this 10th day of October, 2000, as first-class mail, postage prepaid, in an envelope addressed to:
Assistant Commissioner For Patents, Washington, DC 20231.

(s) _____
Linda S. Evans

L. TUCK
#16
10/27/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re U.S. Patent Application of:	Hong et al.	Examiner: R. Covington
Serial No.:	08/916,527	Group Art Unit: 1625
Filed:	August 22, 1997	
For:	NEUROPEPTIDE-Y LIGANDS	Atty. Docket No.: ALANEX.006A

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

RECEIVED
OCT 26 2000
TECH CENTER 1600/2900

Assistant Commissioner For Patents
Washington, DC 20231

Sir:

This is a response to the Office Action mailed April 10, 2000. A petition for a three-month extension of time accompanies this response along with the requisite fee. If any fees other than those submitted herewith are due in connection with this response, please charge all such required fees to Deposit Account No. 500329.

Claims 11-25 are pending. These claims stand rejected under 35 U.S.C. 103(a) based on U.S. Patent No. 5,482,947 (Talley et al.) in view of U.S. Patent No. 5,380,945 (Murad et al.). Applicant respectfully requests reconsideration and withdrawal of the rejection based on the following remarks.

In rejecting the claims, the Examiner argued:

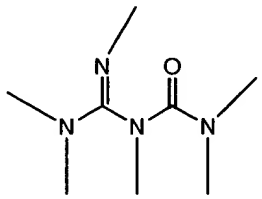
> Talley et al teach compounds of the type claimed. See column 2 lines 25-50+, column 3 lines 35-49. The limitations of the reference overlap the claimed invention in such a way, e.g. at the equivalent substituents for Y, R^3, R^4 and R^5, that the [claimed invention] would have been obvious to one of ordinary skill in the art due to their close structural relationship. This is particularly true in view of [Murad] et al which also teach analogous derivatives. See column 3 line 55+ and column 4 line 1+. It is noted that the corresponding R^6 substituents in applicants' claimed derivatives are well-known protecting groups for use with these type compounds. See column 8 lines 3-8.

A bare contention that the primary reference teaches compounds "of the type claimed", or having "close structural relationship" to the compounds claimed, or that in certain respects "overlap" the claimed compounds, fails to establish a *prima facie* case of obviousness. Similarly, the mere assertion that the secondary reference teaches "analogous derivatives" fails to satisfy the Examiner's burden.

The Examiner has not identified the specific differences between the compounds of Talley et al. and the compounds of the claims. Nor has the Examiner explained why the artisan would have been motivated to make each structural modification to the compounds of Talley et al. necessary to achieve the compounds defined in claim 13, let alone in the claims dependent thereon. The deficiencies in the rejection are not surprising, for the person of ordinary skill in the art neither would have been motivated to combine the teachings of Murad et al. with those of Talley et al., nor would have arrived at claimed invention even if the teachings were combined as proposed by the Examiner.

The Talley et al. compounds are described as being retroviral protease inhibitors, more particularly, HIV protease inhibitors. In contrast, the Murad et al. compounds are disclosed as being nitric oxide synthase regulators, more particularly, cGMP modulators. Because of their diverse utilities, the artisan would not have looked to combine the teachings of Murad et al. with those of Talley et al.

Even assuming *arguendo* that the artisan would have combined the teachings of the secondary reference with those of the primary reference, the claimed invention would not have been achieved. There are various structural distinctions of the claimed compounds that the prior art neither teaches nor suggests. For example, neither the Talley et al. reference nor the Murad et al. reference teaches or suggests compounds containing the following backbone structure:

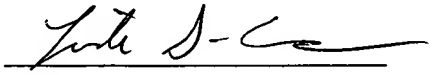


The rejection fails to set forth why or how the artisan would have modified the Talley et al. compounds in view of the prior art so as to arrive at compounds with such a backbone. The rejection also fails to explain why or how the artisan would have selectively picked each of the moieties attached to the backbone structure so as to arrive at the claimed compounds. Consequently, the rejection of claims 13-25 is in error and should be withdrawn.

For the foregoing reasons, compound claims 13-25, composition claim 12, and method claim 11 patentably define over the prior art. Method claim 12 patentably distinguishes over the prior art for an additional reason--the references neither teach nor suggest using any compound in a method of treating a mammal for a disorder of neuropeptide Y activity.

Accordingly, claims 13-25 are allowable. Applicant therefore requests favorable action.

Respectfully submitted,



Linda S. Evans
Registration No. 33,873
Attorney for Agouron Pharmaceuticals, Inc.
10350 North Torrey Pines Road
La Jolla, California 92037

Date: October 10, 2000

0035-01-US